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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,375	01/04/2001	Eckhard Puerkner	646-115	4059

423 7590 11/04/2002

HENKEL CORPORATION  
2500 RENAISSANCE BLVD  
STE 200  
GULPH MILLS, PA 19406

EXAMINER

GALLAGHER, JOHN J

ART UNIT	PAPER NUMBER
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1733

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DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/700325

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 29 JULY 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 13-19, 21-26 and 28-36 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 13-19, 21-26 and 28-36 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other REFERENCE TO DRAWING

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1. The disclosure is objected to because of the following informalities: Page 11 line 18 - the term "polyethylene GLYCOL" is apparently inaccurate (i.e. no apparent previous mention made of this term).

Appropriate correction is required.

2. Claims 32-36 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically (a) the chain extender recited (viz. in claims 32 and 35-36) is (1) apparently nowhere stipulated as being or characterized as "hydrophobic"; and (2) disclosed as being "short chain"; (b) the term "6 to 36 carbon atoms" is inconsistent with the term "4 to 44 carbon atoms" recited in the specification; and (c) there is apparently no support at all in the specification (and none has been cited) for the limitations of claim 35 in its entirety; regarding all of the foregoing, N.B. (and compare) page 11 line 22 thru page 12 line 10 and page 13 line 29 thru page 15 line 4 of applicants' specification. This could be considered to be a new matter rejection; further along this line, however, N.B. paragraph 25 of Corometrics v. Berkeley 193 USPQ 467.

3. Claims 32-36 are further rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

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particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically (a) claim 32 delete the (1) word "as" in line 4; and (2) term "a chain extender" in lines 2-3; and (b) claim 35 line 3 - change "monools" to "mono-ols".

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 13-15 and 31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cooper et al.

6. Claims 1 and 13-15 are further rejected under 35 U.S.C. § 102(b) as being anticipated by Miller et al.

7. Claims 16, 19, 21-26 and 28-30 are rejected, and claims 1 and 13-15 are still further rejected under 35 U.S.C. § 102(b) as being anticipated by Sirota et al.

8. Claims 17-23 and 25 are rejected, claims 1 and 13-15 are yet still further rejected, and claims 32-36 are still further rejected under 35 U.S.C. § 102(b) as being anticipated by the Japanese KK reference (a translation of which reference is included as a part of this action for the sake of the

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completeness of the applicants' file, with the most pertinent sections of this translation being seen to be as follows: Page 2 lines 16-20, page 3 lines 8-12, page 4 lines 5, 7-10 and the Embodiment Example).

9. Applicants' arguments filed 29 July 2002 have been fully considered but they are not deemed to be persuasive. The foregoing art rejections are adhered to essentially for the reasons of record (see paragraphs 6-9 of the last Office action), with the following being additionally advanced in response to applicants' contentions, comments and arguments made in the amendment: (a) The lower end of applicants' recited solubility range of "at least 3% by weight" (viz. 3%) is seen to encompass and indicate a (very) slight degree of solubility; further along this line, N.B. (1) column 4 lines 52-54 of Cooper et al. (i.e. READILY MOISTENED (i.e. solubilized) by contact with even non-liquid water); (2) and compare the teaching of and (sulfo monomer containing) adhesives employed by Miller et al. with applicants' specification at page 7 lines 18-25; (3) column 1 lines 40-42 of Sirota et al. (and compare with page 2 line 19 thru page 3 line 5 of applicants' specification; and (4) the Embodiment Example at page 4 lines 14-20 of the Japanese KK reference translation; (b) the water soluble and nonionic polyurethane adhesive of the KK reference is composed of the reaction product of a polyoxyalkylene glycol, a polyisocyanate

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and a (diol) chain extender, in the manner envisioned by applicants; and (c) it would apparently be incumbent upon applicants to demonstrate and/or establish that the adhesives documented in the applied references of record do not indeed possess or exhibit the "cloud point" characteristic claimed by applicants, with this characteristic being disclosed (N.B. page 22 lines 23-25 of applicants' specification) as being merely "A preferred embodiment" (i.e. rather than critical or even necessary in all instances or at all).

10. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE

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PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

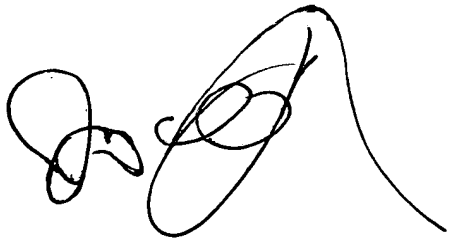
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) <sup>872-9311</sup>~~305-2599~~.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

  
JJGallagher:cdc

October 28, 2002

  
JOHN J. GALLAGHER  
PRIMARY EXAMINER  
ART UNIT 1733